

### REMARKS

This response is filed in reply to the Office Action mailed December 13, 2002. Claims 15, 22 and 23 have been canceled. Claims 16, 17, 18 and 21 have been amended. New claim 24 have been added. Support for the amended claims and new claim can be found throughout the specification. No new matter has been added. Attached is a marked-up version of the changes being made by the current amendment.

#### Objections

Claim 15 is objected to for the recitation of "A antibody." Applicant's note that claim 15 has been canceled.

#### I. REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH

##### *Enablement*

Claim 16 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter not enabled by the specification. While Applicant's respectfully traverse this rejection, it is noted that a declaration indicating that E. coli ATCC 69522 was deposited with the ATCC. In view of the declaration, Applicant's request that this rejection be withdrawn.

#### II. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 15-23 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is moot with regard to cancelled claims 15, 22 and 23. Applicants respectfully traverse this rejection.

Claim 16 has been amended to recite "An isolated antibody produced by E. coli ATCC 69522." Claims 17-21 ultimately depend from claim 16. Claim 16 provides the appropriate antecedent basis for the term "antibody." Applicant's believe that this amendment renders the rejection moot.

Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §112, second paragraph, be withdrawn.

III. PROVISIONAL OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS

Claims 15-20, 22 and 23 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of copending Application No. This rejection is moot with regard to cancelled claims 15, 22 and 23. While Applicants respectfully traverses this rejection, a terminal disclaimer accompanies the present response. Accordingly, Applicants request that this rejection be withdrawn.

IV. REJECTIONS UNDER 35 U.S.C. §102(a) or 103(a)

Claims 15-20, 22 and 23 stand rejected under §102(a) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Burioni et al. (1994). This rejection is moot with regard to cancelled claims 15, 22 and 23. Applicant's respectfully traverse this rejection.

Applicant notes that this application claims priority to U.S. application serial no. 08/316,914, filed October 3, 1994. Accordingly, Applicant requests that the rejection under 35 U.S.C. §102(a) or §103(a), be withdrawn.

Applicant : Burton et al.  
Serial No. : 10/079,802  
Filed : February 19, 2002  
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Con.1/SCR 1994P

In summary, for the reasons set forth herein, Applicant maintains that currently pending claims 16, 17-19, 21 and 24 clearly and patentably define the invention. Applicant requests that the Examiner reconsider the various grounds set forth in the Office Action.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicants' representative can be reached at (858) 678-5070. Payment of the one-month extension fee set forth in 37 CFR §1.17(a)(2) is submitted herewith. Please charge any additional fees, or make any credits, to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 4/14/03

  
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**Version with markings to show changes made**

**In the claims:**

Claims 15, 22 and 23 have been cancelled.

Claims 16-18 and 21 have been amended as follows:

15. **(Canceled)** A antibody that binds to a previously unknown epitope on a preselected antigen, said antibody obtained by the method comprising:

a) forming an immunocomplex by contacting the preselected antigen with a first antibody bound to a solid support, wherein the first antibody specifically binds to a preselected epitope present on the preselected antigen;

b) contacting the immunocomplex of a) with a combinatorial library of antibodies under conditions that allow binding of the second antibody to the previously unknown epitope, wherein a second antibody is obtained from screening the combinatorial library;

c) removing the second antibody of b) from the previously unknown epitope; and

d) obtaining the second antibody.

16. **(Twice Amended)** [The antibody of claim 15, wherein the] An isolated antibody [has the specificity of an antibody] produced by E. coli ATCC 69522.

17. **(Amended)** The antibody of claim [15] 16, wherein the [first] antibody is an Fb or an Fab fragment.

18. **(Amended)** The antibody of claim [15] 16, wherein the antibody binds to an antigen [is] selected from the group consisting of a bacterial, a viral, a parasitic, a fungal, a tumor and a self-antigen.

19. **(Reiterated)** The antibody of claim 18, wherein the viral antigen is selected from the group of viruses consisting of a hepatitis B virus (HBV), a human immunodeficiency virus (HIV), an influenza A virus, an Epstein Barr virus (EBV), a herpes simplex virus (HSV), a

respiratory syncytial virus (RSV), a human cytomegalovirus (HCMV), a varicella zoster virus (VZV), and a measles virus.

20. **(Reiterated)** The antibody of claim 19, wherein the viral antigen is a HSV glycoprotein D.

21. **(Amended)** The antibody of claim [15] 16, wherein the [preselected epitope is a non-neutralizing epitope] antibody neutralizes infectivity of herpes simplex 1 and herpes simplex 2 virus.

22. **(Canceled)** The antibody of claim 15, wherein the previously unknown epitope is a neutralizing epitope.

23. **(Canceled)** The antibody of claim 17, further comprising sequencing a nucleic acid encoding an amino acid sequence of the second antibody.

New claim:

24. A composition comprising an antibody of claim 15.

*Canceled*